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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,912	06/09/2000	Douglas Corning	SCHW-410	3491

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EXAMINER

KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/591,912

Applicant(s)

CORNING ET AL

Examiner

Stefano Karmis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 19-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This communication is in response to Applicants' amendment filed on 22 March 2004.

#### ***Status of Claims***

2. Claims 1, 2, 8, 14, 21, and 29 have been amended. Claim 18 has been cancelled. Remaining claims have been left as previously presented or originally filed. Therefore claims 1-17 and 19-38 are under prosecution in this application.

#### ***Summary of this Office Action***

3. Applicants' arguments filed on 22 March 2004 have been fully considered and are discussed in the section below or within the following rejection. Claims 1-17 and 19-38 have been rejected under newly cited prior art and Applicants' request for allowance is respectfully denied.

#### ***Response to Applicants' Amendment***

4. Examiner acknowledges Applicants' arguments with respect to the 35 USC 102 rejection and 35 USC 103 rejection to Minton, US Patent 6,014,643 and therefore withdraws the previous Office Action's rejections. Any remaining arguments are considered moot in view of the newly established grounds of rejection.

***Claim Rejections - 35 USC § 112***

5. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "wherein securities". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-10, 12-17, and 19-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Gatto U.S. Patent 6,681,211.

Regarding independent claim 1, Gatto discloses a method of organizing a plurality of times which are being tracked in a computing device of the type which is capable of exchanging

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information with a communications center comprising: maintaining a data list which includes all of the plurality of items being tracked, wherein the plurality of items being tracked is limited to a predetermined number of items, and wherein maintaining the data list includes storing information received from the communications center in a memory for each item being tracked; including in the data list a category tag for each of the plurality of items being tracked; and displaying in a sublist associated with a designated category tag all of those items in the data list which have the designated category tag (column 8, figure 2 thru column 10, line 53 and Figures 5-8).

Claim 2, providing at least two category tags for at least a first one of the plurality of items being tracked; displaying the first one of the plurality of items being tracked in a first sublist associated with a first designated category tag; and displaying the first one of the plurality of items being tracked in a second sublist associated with a second category tag (column 10, line 19 thru column 11, line 10 and Figure 8).

Claim 3, wherein securities are included among the plurality of items being tracked (column 10, line 19 thru column 11, line 10 and Figure 8).

Claim 4, the computing device is a personal organizer device (column 8, lines 15-28).

Claim 5, the personal organizer device is a handheld device (column 8, lines 15-28).

Claim 6, displaying a running total of the number of items in the data list (Figure 8).

Claim 7, displaying the maximum number of items in the data list (Figure 8).

Claim 8, displaying the running total of the number of items in the data list, and the maximum number of items permitted in the data list (Figure 8).

Claim 9, the data maintaining step includes the step of adding new items to the plurality of items being tracked by way of entering an identifier for each new item (column 10, line 40 thru column 11, line 10).

Claim 10, the new item adding step includes the step of supplying a category tag for each new item (column 10, line 40 thru column 11, line 10).

Claims 12-13, the displaying step includes the step of including selected information about the items being displayed in the sublist which information includes information received from the communications center and displaying the data list (column 10, line 6-52 and Figure 8).

Regarding independent claim 14, Gatto discloses a system for tracking a plurality of items comprising: a computing device in which information related to each of the plurality of the items being tracked is maintained in a data list, wherein the related information for each of the plurality of items includes a classification tag, and wherein the data list and the classification tags

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are stored in a memory of the computing device; and a central communications center which is capable of exchanging with the computing device the related information of the items being tracked; wherein the computing device operates to store information received from the central communications center for each of the items being tracked, and wherein in the computing device operates to limit the number of items being tracked to a predetermined number; wherein the computing device is capable of displaying a list of all of the plurality of items being tracked by identifier and the associated classification tag and displaying information received from the central communications center for all of the plurality of items being tracked; and is capable of displaying sublists of the plurality of the items being tracked organized by classification tag along with information about the items received from the central communication center in the displayed sublist (column 8, line 40 thru column 11, line 10 and Figure 1 and Figures 5-8).

Claim 15, the computing device is a personal organizer device (column 8, lines 15-28).

Claim 16, the personal organizer device is a handheld device (column 8, lines 15-28).

Claim 17, wherein the items being tracked are securities (column 10, line 19 thru column 11, line 10 and Figure 8).

Claim 19, displaying a running total of the number of items in the data list (Figure 8).

Claim 20 displaying the maximum number of items in the data list (Figure 8).

Claim 21, displaying the running total of the number of items in the data list, and the maximum number of items permitted in the data list (Figure 8).

Regarding independent claim 22, Gatto discloses a computer implemented method for securities trading that comprises maintaining a data list which includes all of the plurality of items being tracked; including in the data list a category tag for each of the plurality of items being tracked; and displaying in a sublist associated with a designated category tag all of those items in the data list which have the designated category tag (column 10, line 19 thru column 11, line 10 and Figure 8).

Claim 23, the computing device is a personal organizer device (column 8, lines 15-28).

Claim 24, the personal organizer device is a handheld device (column 8, lines 15-28).

Claim 25, wherein the items being tracked are securities (column 10, line 19 thru column 11, line 10 and Figure 8).

Claim 26, the number of items being tracked is limited to a predetermined number (column 10, line 19 thru column 11, line 10).

Claim 27, displaying a running total of the number of items in the data list (Figure 8).



Claim 28 displaying the maximum number of items in the data list (Figure 8).

Claim 29, displaying the running total of the number of items in the data list, and the maximum number of items permitted in the data list (Figure 8).

Regarding independent claim 30, Gatto discloses a software program which is adapted for execution in a computing device of the type which is capable of exchanging information with a central communications center, comprising: a data list in which information is maintained for each of a plurality of items being tracked by a user, wherein the information for each item includes an associated one of a plurality of user-supplied classification tags; a display function which is capable of displaying the data list and of displaying lists of ones of the plurality of items being tracked which have common classification tags, along with information about the items in the lists which has been obtained from the central communications center (column 10, lines 19 thru column 11, line 10 and Figure 8).

Claim 31, the computing device is a personal organizer device (column 8, lines 15-28).

Claim 32, the personal organizer device is a handheld device (column 8, lines 15-28).

Claim 33, wherein the items being tracked are securities (column 10, line 19 thru column 11, line 10 and Figure 8).

Claim 34, the number of items being tracked is limited to a predetermined number (column 10, line 19 thru column 11, line 10).

Claim 35, displaying a running total of the number of items in the data list (Figure 8).

Claim 36, displaying the maximum number of items in the data list (Figure 8).

Claim 37, displaying the running total of the number of items in the data list, and the maximum number of items permitted in the data list (Figure 8).

Regarding independent claim 38, Gatto discloses a method for organizing information for a plurality of securities which are being tracked in a hand held computing device of the type which is capable of exchanging information with a communication center comprising: maintaining a data list in the hand held computing device, which includes information of all of the plurality of items being tracked; transmitting information for all of the plurality of securities being tracked from the communication center to the hand held computing device over a wireless link; including in the data list at least one category tag for each of the plurality of the securities being tracked; for at least a first one of the securities being tracked providing at least two category tags; and displaying in a sublist associated with a designated category tag all of those securities in the data list which have the designated category tag, wherein the first security which has at least two different category tags, will be displayed in at least two different sublists of

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securities based on the at least two category tags provided for the first security (column 8, lines 15-28, column 10, line 19 thru column 11, line 10 and Figure 6-8).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto U.S. Patent 6,681,211.

Claim 11, Minton teaches the number of items being tracked is limited to a certain number based on what is available for trade (column 10, lines 28-42). Minton fails to teach that user must delete at least a selected one of the plurality of items being tracked whenever the number of items being tracked will exceed a predetermined limit number because of the addition of the new item. Official Notice is taken that adding and deleting from a list is old and well known in the computer arts. Therefore it would have been obvious at the time of the Applicants' invention to require the deletion of an item if new items are to be added to a list that is already at a predetermined limit because it allows for the newly desired item to be viewed by the user and space is required in the list, which can only be provided by eliminating items already in the list.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Cwenar, US Patent 5,893,079 Apr. 6, 1999. System for Receiving, Processing, Creating, Storing and Disseminating Investment Information.
- b) Kitchen et al., US Patent 6,289,322 Sept. 11, 2001. Electronic Bill Processing.
- c) Patterson, Jr. et al., US Patent 6,539,362 Mar. 25, 2003. Two-Way Wireless System for Financial Industry Transactions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

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13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted  
Stefano Karmis  
01 June 2004



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PRIMARY EXAMINER